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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,092	02/21/2002	Barton A. Pasternak	35783-152950	2819
23973	7590	07/07/2005		
DRINKER BIDDLE & REATH ATTN: INTELLECTUAL PROPERTY GROUP ONE LOGAN SQUARE 18TH AND CHERRY STREETS PHILADELPHIA, PA 19103-6996			EXAMINER NEGRON, ISMAEL	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

gm

Office Action Summary

Application No.

10/081,092

Applicant(s)

PASTERNAK ET AL.

Examiner

Ismael Negron

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on May 6, 2005 has been entered. Claim 6 has been amended. No claim has cancelled, or added. Claims 1-3 and 5-13 are still pending in this application, with claims 1, 7, 8 and 13 being independent.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *rotatable upper portion being adapted to rotate at least 360 degrees about an axis perpendicular to the lower portion* (as recited in claims 5 and 12) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 5, 6 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by WOHL (U.S. Pat. 2,190,439).

5. WOHL discloses an adjustable illumination device having:

- **a directionally adjustable socket adapter (as recited in claims 1 and 13), as seen in Figure 1;**
- **a rotatable upper portion (as recited in claims 1 and 13), Figure 1, reference number 20;**
- **the upper portion being for receiving a light bulb (as recited in claims 1 and 13), as seen in Figure 1;**

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- **a lower portion (as recited in claims 1 and 13), Figure 1, reference number 10;**
- **the lower portion being adapted to engage a socket (as recited in Claim 1), column 1, lines 1-5;**
- **the rotatable upper portion being hingedly attached to the lower portion (as recited in claims 1 and 13), as evidenced by Figure 2;**
- **the upper portion also being rotatably attached to the lower portion (as recited in claims 1 and 13), column 2, lines 5-13;**
- **the directionally adjustable socket adapter being able to be positioned in a plurality of alternative directional arrangements (as recited in Claim 1), column 1, lines 6-10;**
- **the rotatable upper portion being adapted to rotate at least 360° about an axis perpendicular to the rotatable upper portion (as recited in Claim 1), column 1, lines 6-10;**
- **the rotatable upper portion having an outer housing (as recited in Claim 2), Figure 1, reference number 20;**
- **the rotatable upper portion having an inner socket (as recited in Claim 2), inherent;**
- **the directionally adjustable socket adapter being adapted so that the socket adapter can be further adjusted by angularly**

- positioning the rotatable upper portion in relation to the lower portion as desired (as recited in Claim 5), column 1, lines 6-10;
- the directionally adjustable socket adapter being adapted so that the socket adapter can be further adjusted by rotating the angularly positioned rotatable upper portion to a desired point within an at least 360° range of rotation about an axis parallel to the lower portion (as recited in Claim 5), column 1, lines 34-54;
 - a light bulb (as recited in Claim 6), Figure 1, reference number 21;
 - the lower portion being adapted so that the directionally adjustable socket adapter may be rotated at least 360° about at least one axis of rotation (as recited in Claim 13), column 1, lines 34-54;
 - the lower portion being also adapted so that the directionally adjustable socket adapter may be angularly positioned in a plurality of angular positions about an axis different from the at least one axis of rotation (as recited in Claim 13), column 1, lines 6-10; and
 - the lower portion being adapted for positioning the adjustable socket in a plurality of alternative directional arrangements (as recited in Claim 13), column 1, lines 6-10.

6. The applicant is advised that it has been held by the courts that the recitation that an element is "adapted to" perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In this case, the patented structure of WOHL discloses all the claimed structural limitations, such structure was considered capable of performing all of the claimed functions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over WOHL (U.S. Pat. 2,190,439) in view of ANGOTT (U.S. Pat. 4,684,822).

8. WOHL discloses an adjustable illumination device having:

- **a directionally adjustable socket adapter (as recited in Claim 1), as seen in Figure 1;**
- **a rotatable upper portion (as recited in Claim 1), Figure 1, reference number 20;**

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- **the upper portion being for receiving a light bulb (as recited in Claim 1), as seen in Figure 1;**
- **a lower portion (as recited in Claim 1), Figure 1, reference number 10;**
- **the lower portion being adapted to engage a socket (as recited in Claim 1), column 1, lines 1-5;**
- **the rotatable upper portion being hingedly attached to the lower portion (as recited in Claim 1), as evidenced by Figure 2;**
- **the upper portion also being rotatably attached to the lower portion (as recited in Claim 1), column 2, lines 5-13;**
- **the directionally adjustable socket adapter being able to be positioned in a plurality of alternative directional arrangements (as recited in Claim 1), column 1, lines 6-10;**
- **the rotatable upper portion being adapted to rotate at least 360° about an axis perpendicular to the rotatable upper portion (as recited in Claim 1), column 1, lines 6-10;**
- **the rotatable upper portion having an outer housing (as recited in Claim 2), Figure 1, reference number 20; and**
- **the rotatable upper portion having an inner socket (as recited in Claim 2), inherent.**

9. WOHL disclose all the limitations of the claims, except the outer including a plurality of sensors adapted to receive a remote signal for controlling the brightness of a light bulb in response to the signal (as recited in Claim 3).

10. ANGOTT disclose a lamp dimmer system for remotely controlling lamps.

11. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include the lamp dimmer circuit of ANGOTT in the illumination device of WOHL and CHAN to be able to remotely control the operation of such illumination device, as per the teachings of ANGOTT (see column 1, lines 27-49).

12. In addition, the applicant is advised that it has been held by the courts that the recitation that an element is "adapted to" perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In this case, the patented structure of WOHL discloses all the claimed structural limitations, such structure was considered capable of performing all of the claimed functions.

13. Claims 7-9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WOHL (U.S. Pat. 2,190,439).

14. WOHL discloses an adjustable illumination device having:

- **a light bulb (as recited in Claim 8)**, Figure 1, reference number 21;

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- **a directionally adjustable socket adapter (as recited in claims 7 and 8), as seen in Figure 1;**
- **a rotatable upper portion (as recited in claims 7 and 8), Figure 1, reference number 20;**
- **the upper portion being for receiving a light bulb (as recited in claims 7 and 8), as seen in Figure 1;**
- **a lower portion (as recited in claims 7 and 8), Figure 1, reference number 10;**
- **the lower portion being adapted to engage a socket (as recited in claims 7 and 8), column 1, lines 1-5;**
- **the rotatable upper portion being hingedly attached to the lower portion (as recited in claims 7 and 8), as evidenced by Figure 2;**
- **the upper portion also being rotatably attached to the lower portion (as recited in claims 7 and 8), column 2, lines 5-13;**
- **the directionally adjustable socket adapter being able to direct light emitted by the light bulb to a particular location as desired (as recited in claims 7 and 8), column 1, lines 6-10;**
- **the rotatable upper portion having an outer housing (as recited in Claim 9), Figure 1, reference number 20;**
- **the rotatable upper portion having an inner socket (as recited in Claim 9), inherent;**

- **the rotatable upper portion being adapted to rotate at least 360° about an axis perpendicular to the rotatable upper portion (as recited in Claim 11), column 1, lines 6-10;**
- **the directionally adjustable socket adapter being adapted so that the socket adapter can be further adjusted by angularly positioning the rotatable upper portion in relation to the lower portion as desired (as recited in Claim 12), column 1, lines 6-10;**
- **the directionally adjustable socket adapter being adapted so that the socket adapter can be further adjusted by rotating the angularly positioned rotatable upper portion to a desired point within an at least 360° range of rotation about an axis parallel to the lower portion (as recited in Claim 12), column 1, lines 34-54.**

15. WOHL disclose all the limitations of the claims, except the light bulb having a coating adapted to focus light emitted by the bulb in a particular direction (as recited in claims 7 and 8).

16. The Examiner take Official Notice that the use and advantages of coated light bulbs is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include such light bulb in the device of WOHL (as recited in claims 7 and 8) to increase the efficiency of the

illumination device by concentrating and directing towards a desired direction of illumination light rays that would otherwise be directed in other directions.

17. In addition, the applicant is advised that it has been held by the courts that the recitation that an element is "adapted to" perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In this case, the patented structure of WOHL discloses all the claimed structural limitations, such structure was considered capable of performing all of the claimed functions.

18. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over WOHL (U.S. Pat. 2,190,439) in view of ANGOTT (U.S. Pat. 4,684,822).

19. WOHL discloses an adjustable illumination device having:

- **a light bulb (as recited in Claim 8)**, Figure 1, reference number 21;
- **a directionally adjustable socket adapter (as recited in Claim 8)**, as seen in Figure 1;
- **a rotatable upper portion (as recited in Claim 8)**, Figure 1, reference number 20;
- **the upper portion being for receiving a light bulb (as recited in Claim 8)**, as seen in Figure 1;

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- **a lower portion (as recited in Claim 8), Figure 1, reference number 10;**
- **the lower portion being adapted to engage a socket (as recited in Claim 8), column 1, lines 1-5;**
- **the rotatable upper portion being hingedly attached to the lower portion (as recited in Claim 8), as evidenced by Figure 2;**
- **the upper portion also being rotatably attached to the lower portion (as recited in Claim 8), column 2, lines 5-13;**
- **the directionally adjustable socket adapter being able to direct light emitted by the light bulb to a particular location as desired (as recited in Claim 8), column 1, lines 6-10;**
- **the rotatable upper portion having an outer housing (as recited in Claim 9), Figure 1, reference number 20; and**
- **the rotatable upper portion having an inner socket (as recited in Claim 9), inherent.**

20. WOHL disclose all the limitations of the claims, except the outer including a plurality of sensors adapted to receive a remote signal for controlling the brightness of a light bulb in response to the signal (as recited in Claim 3).

21. ANGOTT disclose a lamp dimmer system for remotely controlling lamps.

22. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include the lamp dimmer circuit of ANGOTT in the

illumination device of WOHL and CHAN to be able to remotely control the operation of such illumination device, as per the teachings of ANGOTT (see column 1, lines 27-49).

23. In addition, the applicant is advised that it has been held by the courts that the recitation that an element is "adapted to" perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In this case, the patented structure of WOHL discloses all the claimed structural limitations, such structure was considered capable of performing all of the claimed functions.

Response to Arguments

24. Applicant's arguments filed May 6, 2005 have been fully considered but they are not persuasive.

25. Regarding the Examiner's objection to the drawings under 37 CFR 1.83(a), the applicant argues that the drawings show what is claimed as the specification defines the axis of rotation of leg 24 as perpendicular to the axis.

26. In response to applicant's arguments about the drawings, the applicant is respectfully directed to paragraph 28, lines 8 and 9 (of the specification as filed). Contrary to applicant's argument's, the specification does not "*clearly define*" the axis of rotation of leg 24, but merely provides an example. As the applicant is surely aware, the

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claims of a patent application must be interpreted as broadly as their terms reasonable allow (*In re American Academy of Science Tech Center*, 70 USPQ2d 1827), and such terms are presumed to have the ordinary and customary meanings (emphasis added) attributed by those of ordinary skill in the art (*Sunrace Roots Enterprise Corporation v. SRAM Corporation*, 67 USPQ2d 1438). While it is true that the applicant can be his own lexicographer, applicant's new definition of a known term must be set forth with reasonable clarity, deliberateness and precision so as to give one of ordinary skill in the art notice of the change (*Intellical, Inc. v. Phonometrics, Inc.*, 21 USPQ2d 1383). Applicant's "in example" language was considered wanting in meeting this standard.

However, even if, in arguendo, applicant's definition of the rotation axes was considered appropriate, the Drawings would still fail to disclosed the claimed subject matter. The disclosed embodiments include two different mechanisms for providing rotatable adjustment: hinge 35, and the rotatable structure coupling bottom leg 24 to lower portion 25. Rotation of at least 360° is not possible by means of hinge 35 (common to all embodiments) as detailed in the previous Office actions. As clearly stated in the specification (see paragraphs 16 and 19, lines 5-10 and 4-16 respectively, of the specification as filed), in the embodiment shown by figures 1 and 2, rotation of the upper portion 15 is limited to 360° to "prevent wires located within the adjustable socket adapter from twisting", but since the stopping mechanisms 42a and 42b must have a thickness, the actual maximum rotation of upper portion 15 is undeniably below 360°. Even the embodiment presented in Figure 4, while devoid of the "twisted wires"

problem, is incapable of "at least 360° rotation" of the upper portion 15 as it also includes a stopping mechanism, namely stop 46.

27. Regarding the Examiner's rejection of claims 1 and 13 under 35 U.S.C. 102(b) as being anticipated by WOHL (U.S. Pat. 2,190,439), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically "the rotatable upper portion being adapted to rotate at least 360° about an axis perpendicular to the rotatable upper portion". The applicant further argues that the Examiner previously acknowledge the cited reference as lacking the claimed features.

28. In response to applicant's arguments that WOHL fails to disclose the rotatable upper portion being adapted to rotate at least 360° about an axis perpendicular to the rotatable upper portion, the applicant is directed to Section XI(A) of his own Appeal Brief (filed November 29, 2004) where it was convincingly argued that the structure disclosed by WOHL was indeed capable sweeping out both halves of a circle (360° rotation).

The patented device of WOHL do provide rotation of at least 360° as claimed. The fact that such range of rotation is accomplished in two intervals (rotating the socket 180°, then turning it about the hinge, and then rotating the socket another 180°) is irrelevant to the language of the claims. In fact, in order for applicant's invention to achieve such "at least 360°" rotation the same exact procedure must be followed as the disclosed structure is not capable of continuous 360° rotation (see the discussion of the drawings in previous Section 26).

29. Regarding the Examiner's rejection of claims 2, 5 and 6 under 35 U.S.C. 102(b) as being anticipated by WOHL (U.S. Pat. 2,190,439), the applicant present no arguments, except stating that such claims depend directly or indirectly from independent Claim 1 and would be allowable when/if the independent claim is allowed.

30. Regarding the Examiner's rejection of Claim 8 under 35 U.S.C. 102(b) as being anticipated by WOHL (U.S. Pat. 2,190,439), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically "a structure capable of rotating 360°".

31. In response to arguments that WOHL fails to disclose the patented structure being capable of rotating 360°, the applicant is advised that, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, it is noted that the features upon which applicant relies (the structure capable of rotating 360°) are not recited in the rejected claim.

Regarding Claim 11, which do recited rotation of at least 360°, the applicant is directed to previous Section 28 where such limitation is discussed as it applies to Claim 1.

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32. Regarding Claim 7, while the limitations of such claim were rejected in Section 10 of the previous Office Action, Claim 7 was inadvertently not directly and specifically referenced, as the applicant pointed out. To clarify the prosecution record the instant Office Action has being issued as a Non-Final Office Action.

Conclusion

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you

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have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



THOMAS M. SEMBER
PRIMARY EXAMINER


Inr

June 30, 2005